

Appln. No. 10/625,252  
Amendment dated June 26, 2008  
Reply to Office Action mailed March 28, 2008

RECEIVED  
CENTRAL FAX CENTER

JUN 26 2008

**REMARKS**

Reconsideration is respectfully requested.

Claims 1, 3, 5 through 7, 9 through 13 and 15 through 23 remain in this application. Claims 2, 4, 8 and 14 have been cancelled. No claims have been withdrawn. Claim 24 has been added.

Claims 1, 3, 5 through 7, 9 through 13, 15 through 23 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Roth in view of Kiely and further in view of Katz.

Claim 1 requires, in part, "including, by the seller during the occurrence of the sales transaction, the real-time marketing opportunity corresponding to the winning bid such that the customer is capable of taking advantage of the real time-marketing opportunity as a part of the primary order for the product of the seller". Claim 7 requires "include, by the seller during the occurrence of the sales transaction, the real-time marketing opportunity corresponding to the winning bid such that the customer is capable of taking advantage of the real time-marketing opportunity as a part of the primary order for the product of the seller". Claim 13 requires "include, by the seller during the occurrence of the sales transaction, the real-time marketing opportunity corresponding to the winning bid such that the customer is capable of taking advantage of the real time-marketing opportunity as a part of the primary order for the product of the seller".

In the rejection, it is conceded that the allegedly obvious combination of Roth and Kiely "does not expressly disclose a customer taking advantage of a real-time marketing opportunity as part of the primary order for the product", but then it is asserted that:

Katz discloses a method comprising a customer taking advantage of a real-time marketing opportunity as part of the primary order for the product of the seller (Katz: abstract). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to

Appln. No. 10/625,252  
Amendment dated June 26, 2008  
Reply to Office Action mailed March 28, 2008

have modified the method of Roth and Kiely to have included an upsell offer as part of the primary offer, as taught by Katz, in order to "incentivise (with an upsell) the potential customer in real time" (Katz: paragraph 33).

However, it is submitted that, as will be shown below, the Katz patent application does not teach a system in which the customer is "capable of taking advantage of the real time-marketing opportunity as a part of the primary order for the product of the seller", as required by the language of the claim. More specifically, the Katz patent application discusses a system in which the secondary transaction cannot be taken advantage of as a part of the primary transaction. See, for example, Figure 7 of Katz (e.g., block 238) and the text of Katz at paragraph [0116], which states (emphasis added):

[0116] FIG. 7 shows a flowchart for one possible path through the system. Upon receiving an initial contact 230, the transaction type may be determined at step 232. Various identification determinations 234 may be collected and then used in determining whether any limitations 236 are to be applied, which if not, the transaction may then be conducted at step 238. Optionally, a credit check 240 may be performed, either for the primary transaction alone, or further, for a potential upsell. The inputs having been collected 242 from prior interaction, database checks 244 may contact and interact with database A 246, database B 248, . . . database N 250, possibly under control when coaction 252 is required. The inputs having been collected are then provided 254 to the system. Optional inventory checks 256 may be performed and then utilized step 258 to determine if the potential upsell item is available. Once the upsell has been determined, the upsell may be offered in step 260, which if purchased at step 262 may then be confirmed and sent to order fulfillment step 264. Optionally, further items may be offered, step 266, in which case the upsell determination may be repeated, or the previously determined second upsell item offered. Typically at the end of the transaction, at step 268 the system will update various databases as appropriate and the upsell system, including the criteria for determining the upsell.

Thus, the Katz system conducts the primary transaction prior to the secondary transaction, which would not lead one of ordinary skill in the art to recognize that "the customer is capable of taking advantage of the real

Appln. No. 10/625,252  
Amendment dated June 26, 2008  
Reply to Office Action mailed March 28, 2008

time-marketing opportunity as a part of the primary order for the product of the seller”.

Figure 6 of the Katz patent application also shows the primary transaction being separate from the follow on transaction—see element 300 of Figure 6.

Looking to paragraph [0033] referenced in the Office Action, it broadly discusses a perceived failing in the prior art, stating:

[0033] Yet another deficiency of certain of the prior art systems is in their failure to incentivise the potential customer in real time. Often times, the best time to offer incentives or alternatives for purchases when the customer has already manifested a desire or interest to purchase. Despite the efforts made over a significant period, an effective, useful system for the intelligent, automated provision of goods and services in the telephonic and electronic commerce areas has been made.

However, while there is criticism of prior systems for “their failure to incentivise the potential customer in real time”, this does not teach one of ordinary skill in the art that “the customer [being] capable of taking advantage of the real time-marketing opportunity as a part of the primary order for the product of the seller” is the answer to the perceived problem. Simply because the potential customer may be “incentivized” in real time does not mean that, or motivate one to make possible, the customer being “capable of taking advantage of the real time-marketing opportunity as a part of the primary order for the product of the seller”.

It is therefore submitted that the Katz patent does not teach “including, by the seller during the occurrence of the sales transaction, the real-time marketing opportunity corresponding to the winning bid such that the customer is capable of taking advantage of the real time-marketing opportunity as a part of the primary order for the product of the seller”, and therefore does not lead one of ordinary skill in the art to the requirements

RECEIVED  
CENTRAL FAX CENTER

JUN 26 2008

Appln. No. 10/625,252  
Amendment dated June 26, 2008  
Reply to Office Action mailed March 28, 2008

of claim 1 that are conceded to be missing from the allegedly obvious combination of Roth and Kiely.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Roth, Kiely and Katz set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1, 7 and 13, as well as the claims that depend from claims 1, 7, and 13, which also include the requirements of claims 1, 7, and 13.

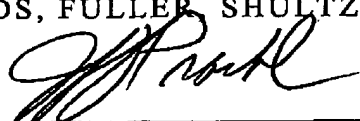
Withdrawal of the §103(a) rejection of claims 1, 3, 5 through 7, 9 through 13, 15 through 23 is therefore respectfully requested.

### CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.

  
\_\_\_\_\_  
Jeffrey A. Proehl (Reg. No. 35,987)  
Customer No. **40,158**  
P.O. Box 5027  
Sioux Falls, SD 57117-5027  
(605)336-3890 FAX (605)339-3357

Date: JUNE 26, 2008